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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,649	02/13/2004	Michael David Metzger	52493.000367	5674
21967 7590 07/16/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
KOPPIKAR, VIVEK D				
ART UNIT		PAPER NUMBER		
3626				
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07/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,649

Applicant(s)

METZGER ET AL.

Examiner

VIVEK D. KOPPIKAR

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/13/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/CIS)
- Paper No(s)/Mail Date all received

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. Claims 1-22 have been examined in this application. This communication is the first action on the merits. As of the date of this communication, all the submitted Information Disclosure Statements (IDS) have been acknowledged.

Claim Objections

2. Claim 17 is objected to because of the following informalities: The term “selectively” in line 21 of this claim appears to be unnecessary. It is inherent that a system will generate metadata regarding only data which is relevant or important to its users. Appropriate explanation or clarification on the reason for use of this term is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 17 is a method claim which does not recite a device for carrying out the method. To overcome this rejection, the Office recommends reciting either a computer or some sort of device which carries out the claimed method.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 6, 10-13, 16-20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable by US Patent Number 6,151,584 to Papierniak in view of US Patent Number 6,415,284 to D'Souza.

(A) As per claim 1, Papierniak teaches a system for performing data collection of insurance related submitted data provided by an applicant for insurance on a submitted form (Papierniak: Abstract) , the system comprising:

a data input portion that inputs the submitted form so that the submitted data on the submitted form is available to a data entry operator (Papierniak: Col. 10, Ln. 47-54 and Col. 21, Ln. 29-35); and

a data collector tool, which processes entered data that is entered by the data entry operator, onto an internal electronic form, based on the submitted data submitted by the applicant (Papierniak: Col. 18, Ln. 51-6), the data collector including:

a form flow portion that presents the data entry operator with a series of form flows for collection of the submitted data, the form flows progressing through various user interface screens in collection of the submitted data, (Papierniak: Col. 6, Ln. 60-62 and Col. 22, Ln. 6-13);

and

a metadata portion that generates metadata, the metadata containing information about entered data, the metadata being progressively generated during progression of the form flows through the various user interface screen (Papierniak: Col. 12, Ln. 2-16 and Col. 21, Ln. 7-10).

Papierniak does not teach the following feature which is taught by D'Souza (Col. 1, Ln. 53-59):

wherein the form flows use content sensitive logic

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Papierniak with the above teachings from D'Souza with the motivation of having a means of validating data, as recited in D'Souza (Col. 1, Ln. 53-54).

(B) As per claim 2, in Papierniak, the metadata is based on input by the data entry operator (Papierniak: Col. 20, Ln. 63-66)

(C) As per claim 3, in Papierniak, the metadata portion presents the data entry operator with a plurality of metadata to choose from so as to capture information about the entered data (Papierniak: Col. 19, Ln. 4-11).

(D) As per claim 6, in Papierniak the metadata portion presents the metadata to the data entry operator using labels that are each associated with at least one field on the internal electronic form (Papierniak: Col. 17, Ln. 52-59).

(E) As per claims 10-11, Papierniak does not explicitly recite that a single label containing the metadata is associated with a single or plural fields on the internal electronic form, however, the Office takes the position that this feature is inherent in Papierniak (Col. 19, Ln 5-10 and Col. 20, Ln. 37-43)) because the cited section of Papierniak discusses managing various sets of metadata. Because the metadata is organized into sets and each set corresponds to a particular business (business's forms), it is inherent that each label for a set of metadata corresponds to at least a single field or multiple fields of information or data which originate from the forms of a business.

(F) As per claim 12, in Papierniak the data collector tool does not include a validation portion, the validation portion performing validation checks on the entered data entered on the internal electronic form, however, this features is well known in the computer software and data management and information technology fields, as illustrated by D'Souza (Col. 1, Ln. 53-59). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Papierniak with the above teachings from D'Souza with the motivation of having a means of validating data, as recited in D'Souza (Col. 1, Ln. 53-54).

(G) As per claim 13, the combined teachings of Paperniak in view of D'Souza do not teach that the validation portion performs a validation process on a field upon exiting a field, however, the Office takes the position that this feature is inherent because a validation module cannot perform a validation process until it has read all the information in a field and this cannot be done until the validation module has exited the field.

(H) As per claim 15, in Papierniak the data tool collector allows a subsequent user to vary the metadata of the internal electronic form after initial entry by the data entry operator and to properly reflect that correction (Papierniak: Col. 21, Ln. 51-62).

(I) As per claim 16, in Papierniak the data input portion processes a scanned version of the submitted form and presents the scanned version of the submitted form to the data entry operator via the user interface (Papierniak: Col. 21, Ln. 29-35).

(J) As per claims 17-19, these claims are substantially similar to Claims 1-3, respectively, and are therefore rejected in the same manner as these claims, as set forth above.

(K) As per claim 20, this claim is substantially similar to Claim 6, above, and is therefore rejected in the same manner as this claim, which is set forth above.

(L) As per claim 21, this claim is substantially similar to Claim 1, above, and is therefore rejected in the same manner as this claim, which is set forth above.

7. Claims 4-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak in view of D'Souza, as applied to Claim 3, above, and in further view of US Patent Application Publication 2004/0123202 to Talagala.

(A) As per claims 4-5, Papierniak does not teach the following feature which is taught by Talagala (Section [0034]):

wherein the data collector tool provides the data entry operator with the ability to reflect deficient information on the submitted form in conjunction with identifying the deficient information with metadata and wherein the deficient information includes at least one of altered information, blank information and unreadable information.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Papierniak in view of D'Souza with the aforementioned teachings from Talagala with the motivation of having a means of detecting errors in data (storage devices), as recited in Talagala (Section [0004]).

(B) As per claim 22, this claim is substantially similar to Claims 1, 5, 6, and is therefore rejected on the same basis as this claim, which is set forth above.

8. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak, as applied to Claim 1, above, and in further view of Official Notice.

(A) As per claims 7-9, Papierniak does not teach the following features, however, the Office takes Official Notice that these features are well known in the software and data management and information technology fields: wherein the metadata portion presents the

metadata to the data entry operator using labels by modifying the labels using font attributes, wherein the font attributes include one of color, bold, underline and italics, and wherein the data entry operator controls the operation of the metadata portion using hotkeys, such that the data entry operator controls the labeling of the fields using metadata as the data entry operator desires, the hotkeys comprising a series of keystrokes.

At the time of the invention, one of ordinary skill in the art would have been motivated to have modified the teachings of Paperniak with the above teachings with the motivation of having a means of clearly and distinctly labeling the metadata and also giving the data entry operator a quick and convenient means of managing the manipulating the metadata portion.

9. Claim 14 is rejected under 35 U.S.C. 103(a) over Papierniak in view of D'Souza as applied to Claim 12, above, and in further view of Official Notice.

The combined teachings of Paperniak in view of D'Souza do not teach that the validation portion performs a validation process on a page upon exiting a page, however, the Office takes the position that this feature is inherent because a validation module cannot perform a validation process until it has read all the information in a field and this cannot be done until the validation module has exited the field.

Papierniak in view of D'Souza do not teach that the internal electronic form is arranged based on pages of the internal electronic form, however, the Office takes the position that this is a feature well known in the software and data management and information technology fields and at the time of the invention one of ordinary skill in the art would have been motivated to have modified the aforementioned teachings of Papierniak in view of D'Souza with the above

teachings with the motivation of having a convenient and logical means of organizing information on the internal electronic form.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Numbers 6,877,134 and 7,062,706 and US Patent Application Publication Numbers 2004/0003353; 2004/0260594 and 2005/0022122 relate to data collection and management systems.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, C. Luke Gilligan, can be reached at (571) 272-6770. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

/Vivek D Koppikar/

Examiner, Art Unit 3626

7/16/2008